

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: <b>HSIEH, H. <i>et al.</i></b>	)	Confirmation No. <b>1755</b>
	)	
Application No. <b>10/776,643</b>	)	Group Art Unit: <b>1656</b>
	)	
Filed: <b>12 February 2004</b>	)	Examiner: <b>DESAI, A.</b>
	)	
For: <b>Binding Proteins as Biosensors</b>	)	

**PETITION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705**

In response to the Notice of Allowance and Fees Due of the above referenced patent application dated November 16, 2009, Applicants submit this petition for patent term adjustment ("PTA") to request a reconsideration of PTA of 1433 days.

For consideration of the petition for PTA, enclosed are the following:

1. Fee set forth under 37 C.F.R. § 1.18(e);
2. Statement of the Facts involved under 37 C.F.R. § 1.705(b); and
3. Copy of Patent Term Adjustment History

In view of the reasons set forth in the Statement of Facts, Applicants respectfully request that the patent term be corrected by adding 1080 additional days to the term of the patent issuing from the above-identified application for a total of 1433 days.

Dated: **February 16, 2010**  
Morgan, Lewis & Bockius LLP  
Customer No. **09629**  
1111 Pennsylvania Avenue, N.W.  
Washington, D.C. 20004  
202-739-3000

Respectfully submitted  
**Morgan, Lewis & Bockius LLP**

/Zachary Derbyshire/

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Zachary E. Derbyshire  
Registration No. 64,669

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: <b>HSIEH, H. <i>et al.</i></b>	)	Confirmation No. <b>1755</b>
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Application No. <b>10/776,643</b>	)	Group Art Unit: <b>1656</b>
	)	
Filed: <b>12 February 2004</b>	)	Examiner: <b>DESAI, A.</b>
	)	
For: <b>Binding Proteins as Biosensors</b>	)	

**STATEMENT UNDER 37 C.F.R. 1.705(b)**

This statement is respectfully submitted in support of the Petition For Patent Term Adjustment Under 37 C.F.R. § 1.705 for the above-referenced patent. In view of the following, it is respectfully requested that Applicants be granted a final patent term adjustment of 1433 days and not 353 as indicated calculated by the Patent Office.

The Patent Term Adjustment (“PTA”) under 35 U.S.C. § 154(b) listed on the above-referenced patent is 353 days. This determination is in error in that pursuant to 35 U.S.C. § 154(b), the Patent Office failed to take certain action within the time frame specified in 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. § 1.702(a) and failed to issue a patent within three years of the actual filing date of the above-referenced application in accordance with 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b). Moreover, the calculation of the PTA available through the electronic Patent Application Information Retrieval Service (PAIR) contains several calculating errors, and mistakenly attributes excess delay on Applicants’ behalf.

The United States Patent Office (USPTO) issued a Notice on 28 January 2010 that indicated that PTA calculations would be recalculated according to the ruling by the Federal Circuit in *Wyeth v. Kappos*, No. 2009-1120 (Fed. Cir. 2009). Accordingly, pursuant to 35 U.S.C. § 154(b)(1)(A), Applicants are entitled to a period of PTA for failure of the Patent Office to comply with statutory deadlines. Under 35 U.S.C. § 154(b)(1)(A)(i), the Patent Office should have issued a first Office Action by 12 April 2005 (within fourteen months of filing the application). This application was filed on 12 February 2004, and the Patent Office mailed a first Office Action on 4 January 2007, 632 days beyond the fourteen month statutory deadline. Accordingly, as the Patent Office has concluded (see attached PTA calculation), Applicants are entitled to a total period of Examination delay of 632 days under 37 C.F.R. § 1.702(b).

However, in addition to the PTA due to delay in commencing examination, pursuant to 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.703(b), Applicants respectfully submit that they are also entitled to a period of PTA due to the failure of the Patent Office to issue a patent within three years of filing the application (12 February 2007). Under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.703(a), this additional

period of PTA commenced 12 February 2007, and will end on or before 25 May 2010, when the patent is projected to issue, 905 days beyond the three year guarantee. Accordingly, the USPTO has caused 1537 days of delay (632+905).

Applicants further submit that the final PTA should reflect Applicants' own delay. The Patent Office issued a Notice to File Missing Parts on 10 May 2004, a response to which was due on or before 10 July 2004. Applicants filed the required parts on 23 September 2004, a period 75 days after the final Office Action mailed on April 11, 2008. Applicants note that the USPTO calculation of this delay only indicates 44 days worth of delay.

The USPTO calculation of PTA further attributes 246 days of delay by Applicants between 5 March 2007 and 6 November 2007. Applicants submit that this period is in error. The Examiner mailed a Restriction Requirement 4 January 2007, a response to which was due 4 February 2007. Applicant filed a response to the Restriction Requirement on 5 March 2007, a delay of 29 days. The USPTO mailed a Notice to Comply on 10 May 2007. The Notice to Comply alleged that a Sequence Listing was required to be submitted. The present application contains no sequences that would necessitate a Sequence Listing. Accordingly, this Notice was in error and Applicants should incur no penalty attributed to any delay. Therefore, as this Notice was in error Applicants submit that they incurred only 104 days of delay (75+29).

As set forth in 37 C.F.R. § 1.703(f), Applicants are entitled to a period of PTA equal to the period of delays based on the grounds set forth in 35 U.S.C. § 154(b) and 37 C.F.R. § 1.702, reduced by the period of time equal to the period of time during which Applicants failed to engage in reasonable efforts to conclude prosecution pursuant to 37 C.F.R. § 1.704. Accordingly, Applicants submit that the Patent Office caused a total delay of 1537 days, lessened by Applicants delay of 104 days. Applicants submit, therefore that the correct PTA for the above-referenced patent is 1433 days.

In view of the foregoing, it is respectfully requested that this Petition for Patent Term Adjustment Under 37 C.F.R. § 1.705 be favorably considered and that a corrected determination of Patent Term Adjustment be issued to reflect a PTA of 1433 days.

Dated: **16 February 2010**  
Morgan, Lewis & Bockius LLP  
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1111 Pennsylvania Avenue, N.W.  
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202-739-3000

Respectfully submitted  
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10/776,643

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**This application is officially maintained in electronic form. To View: Click the desired Document Description. To Download and Print: Check the desired document(s) and click PDF.**

### Bibliographic Data

Mail Room Date	Document Code	Document Description	Document Category	Page Count
11-16-2009	NOA	<b>Notice of Allowance and Fees Due (PTOL-85)</b>	<b>PROSECUTION</b>	<b>4</b>
11-16-2009	NOA	Notice of Allowance and Fees Due (PTOL-85)	PROSECUTION	2
11-16-2009	ANE.I	Amendment After Final or under 37CFR 1.312, initialed by the examiner.	PROSECUTION	1
11-16-2009	IIFW	Issue Information including classification, examiner, name, claim, renumbering, etc.	PROSECUTION	1
11-16-2009	SRFW	Search information including classification, databases and other search related notes	PROSECUTION	1
11-16-2009	SRNT	Examiner's search strategy and results	PROSECUTION	3
10-28-2009	A.NE	Amendment After Final	PROSECUTION	1
10-28-2009	CLM	Claims	PROSECUTION	3
10-28-2009	REM	Applicant Arguments/Remarks Made in an Amendment	PROSECUTION	1
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10-28-2009	WFEE	Fee Worksheet (PTO-875)	PROSECUTION	1
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08-04-2009	SRFW	Search information including classification, databases and other search related notes	PROSECUTION	1
05-06-2009	CRFE	CRF entered - partial listing printed by STIC	PROSECUTION	4
04-29-2009	A...	Amendment/Req. Reconsideration-After Non-Final Reject	PROSECUTION	1
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04-29-2009	NPL	NPL Documents	PRIOR ART	9
04-29-2009	CRFS	CRF Statement Paper and CRF are the same	PROSECUTION	1
04-29-2009	N417	EFS Acknowledgment Receipt	PROSECUTION	2
04-29-2009	SEQ.TXT	Sequence Listing (Text File)	PROSECUTION	1
04-29-2009	WFEE	Fee Worksheet (PTO-875)	PROSECUTION	1
04-23-2009	EXIN	Examiner Interview Summary Record (PTOL - 413)	PROSECUTION	2
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02-18-2009	SRNT	Examiner's search strategy and results	PROSECUTION	1
02-18-2009	SRNT	Examiner's search strategy and results	PROSECUTION	1
11-18-2008	A...	Amendment/Req. Reconsideration-After Non-Final Reject	PROSECUTION	1
11-18-2008	SPEC	Specification	PROSECUTION	3
11-18-2008	CLM	Claims	PROSECUTION	9
11-18-2008	REM	Applicant Arguments/Remarks Made in an Amendment	PROSECUTION	2
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08-19-2008	SRNT	Examiner's search strategy and results	PROSECUTION	1
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08-19-2008	SRNT	Examiner's search strategy and results	PROSECUTION	1
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11-06-2007	A...	Amendment/Req. Reconsideration-After Non-Final Reject	PROSECUTION	1
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03-13-2007	WFEE	Fee Worksheet (PTO-875)	PROSECUTION	1
03-13-2007	WCLM	Claims Worksheet (PTO-2022)	PROSECUTION	1
03-13-2007	WFEE	Fee Worksheet (PTO-875)	PROSECUTION	1
03-05-2007	ELC.	Response to Election / Restriction Filed	PROSECUTION	1
03-05-2007	CLM	Claims	PROSECUTION	8
03-05-2007	REM	Applicant Arguments/Remarks Made in an Amendment	PROSECUTION	4
03-05-2007	WFEE	Fee Worksheet (PTO-875)	PROSECUTION	2
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03-05-2007	REM	Applicant Arguments/Remarks Made in an Amendment	PROSECUTION	4
03-05-2007	N417	EFS Acknowledgment Receipt	PROSECUTION	2
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01-04-2007	BIB	Bibliographic Data Sheet	PROSECUTION	1
07-28-2005	IDS	Information Disclosure Statement (IDS) Filed (SB/08)	PROSECUTION	5
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04-22-2005	N570	Communication - Re: Power of Attorney (PTOL-308)	PROSECUTION	2
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02-18-2005	IDS	Information Disclosure Statement (IDS) Filed (SB/08)	PROSECUTION	11
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02-18-2005	NPL	NPL Documents	PRIOR ART	12

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02-18-2005	NPL	NPL Documents	PRIOR ART	9
02-18-2005	NPL	NPL Documents	PRIOR ART	6
02-18-2005	NPL	NPL Documents	PRIOR ART	7
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02-18-2005	NPL	NPL Documents	PRIOR ART	4
02-18-2005	NPL	NPL Documents	PRIOR ART	9
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02-18-2005	ARTIFACT	Artifact sheet indicating an item has been filed which cannot be scanned	PROSECUTION	1
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02-18-2005	NPL	NPL Documents	PRIOR ART	7
09-23-2004	136A	Authorization for Extension of Time all replies	PROSECUTION	4
09-23-2004	PEFR	Applicant Response to Pre-Exam Formalities Notice	PROSECUTION	4
09-23-2004	XT/	Extension of Time	PROSECUTION	1
09-23-2004	OATH	Oath or Declaration filed	PROSECUTION	7
05-10-2004	PEFN	Pre-Exam Formalities Notice	PROSECUTION	2
02-12-2004	TRNA	Transmittal of New Application	PROSECUTION	1
02-12-2004	SPEC	Specification	PROSECUTION	22
02-12-2004	CLM	Claims	PROSECUTION	13
02-12-2004	ABST	Abstract	PROSECUTION	1
02-12-2004	DRW	Drawings-only black and white line drawings	PROSECUTION	7
02-12-2004	ADS	Application Data Sheet	PROSECUTION	6
02-12-2004	WFEE	Fee Worksheet (PTO-875)	PROSECUTION	1

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**Patent Term Adjustments**

Patent Term Adjustment (PTA) for Application Number: 10/776,643

Filing or 371(c) Date:	02-12-2004	USPTO Delay (PTO) Delay (days):	-
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	-	Applicant Delay (APPL) Delay (days):	-
Post-Issue Petitions (days):	-	Total PTA (days):	353
USPTO Adjustment(days):	-	Explanation Of Calculations	

**Patent Term Adjustment History**

Date	Contents Description	PTO(Days)	APPL(Days)
11-16-2009	Mail Notice of Allowance		
11-10-2009	Document Verification		
11-10-2009	Examiner's Amendment Communication		
11-10-2009	Notice of Allowance Data Verification Completed		
10-31-2009	Date Forwarded to Examiner		
10-28-2009	Amendment after Final Rejection		
08-04-2009	Mail Final Rejection (PTOL - 326)		
08-03-2009	Final Rejection		
06-01-2009	Date Forwarded to Examiner		
04-29-2009	Response after Non-Final Action		
05-06-2009	CRF Is Good Technically / Entered into Database		
04-23-2009	Mail Examiner Interview Summary (PTOL - 413)		
04-22-2009	Examiner Interview Summary Record (PTOL - 413)		
02-18-2009	Mail Non-Final Rejection		
02-17-2009	Non-Final Rejection		
12-06-2008	Date Forwarded to Examiner		
11-18-2008	Response after Non-Final Action		
08-19-2008	Mail Non-Final Rejection		
08-18-2008	Non-Final Rejection		
06-16-2008	Date Forwarded to Examiner		
05-19-2008	Response to Election / Restriction Filed		
05-19-2008	Request for Extension of Time - Granted		
03-17-2008	Mail Restriction Requirement	11	
03-10-2008	Requirement for Restriction / Election	⌘	
03-10-2008	Date Forwarded to Examiner	⌘	
11-06-2007	Response to Election / Restriction Filed		246
03-06-2008	Case Docketed to Examiner in GAU		⌘
07-28-2005	Information Disclosure Statement considered		⌘
05-10-2007	Mail Notice of Informal or Non-Responsive Amendment		⌘
03-08-2007	Date Forwarded to Examiner		⌘
03-05-2007	Supplemental Response		⌘
03-08-2007	Date Forwarded to Examiner		⌘
03-05-2007	Informal or Non-Responsive Amendment after Examiner Action		⌘
03-05-2007	Response to Election / Restriction Filed		⌘



03-05-2007	Request for Extension of Time - Granted		
01-04-2007	Mail Restriction Requirement	632	
12-26-2006	Requirement for Restriction / Election	⌘	
11-08-2006	Case Docketed to Examiner in GAU	⌘	
04-26-2006	IFW TSS Processing by Tech Center Complete	⌘	
07-28-2005	Information Disclosure Statement (IDS) Filed	⌘	
07-28-2005	Information Disclosure Statement (IDS) Filed	⌘	
07-28-2005	Reference capture on IDS	⌘	
04-22-2005	Correspondence Address Change	⌘	
04-22-2005	Change in Power of Attorney (May Include Associate POA)	⌘	
02-18-2005	Reference capture on IDS	⌘	
02-18-2005	Information Disclosure Statement (IDS) Filed	⌘	
02-18-2005	Information Disclosure Statement (IDS) Filed	⌘	
10-08-2004	Application Return from OIPE	⌘	
10-08-2004	Application Is Now Complete	⌘	
10-08-2004	Application Return TO OIPE	⌘	
10-08-2004	Application Return from OIPE	⌘	
10-08-2004	Application Return TO OIPE	⌘	
10-08-2004	Application Dispatched from OIPE	⌘	
10-08-2004	Application Is Now Complete	⌘	
09-23-2004	Payment of additional filing fee/Preexam		44
09-23-2004	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic	⌘	
05-10-2004	Notice Mailed--Application Incomplete--Filing Date Assigned	⌘	
03-30-2004	Cleared by L&R (LARS)		
03-22-2004	Referred to Level 2 (LARS) by OIPE CSR		
02-24-2004	IFW Scan & PACR Auto Security Review		
02-12-2004	Initial Exam Team nn		

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